

## **REMARKS**

This amendment is in response to the office action dated December 4, 2003. In the office action, claims 1-20 were rejected. Claims have been amended. Claims have been canceled. A detailed discussion of each item in the office action follows.

### **THE 112 REJECTION**

In item 2 of the office action, claims 1-3, 7-8 and 10 were rejected under 35 U.S.C. 112, second paragraph. The claims were amended in response to this item of the office action as follows:

Independent claims 1 and 9 were amended to eliminate the reference to location information, and add structural limitations related to generation of the beacon signal.

Dependent claims 2-3 and 7 were amended for clarity.

Dependant claim 8 was amended to add additional limitations related to the nature of the signals transmitted between the tracking device and the remote location.

Applicants' Attorney believes that due to the amendments, this basis of the Examiner's rejection has been overcome, and respectfully asks the Examiner to reconsider these claims with a view towards allowance.

### **JOINT INVENTORS**

In regard to item 6 of the office action, all claims are commonly owned.

### **THE 102(b) REJECTION**

In items 7 of the office action, claims 1-2 and 9-10 were rejected under 35 U.S.C. 102(b), as being anticipated by Culpepper. Claim 10 was canceled, therefore the rejection of that claim is moot. Culpepper does not anticipate Applicants' invention for the following reasons:

1. Culpepper is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.
  2. Culpepper does not disclose the purpose, means or mechanism that this invention discloses.
  3. Culpepper does not solve the problems that this invention solves.
  4. Culpepper does not disclose each and every element of this invention.
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1. **Culpepper is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.**

There is not anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

Culpepper is not capable of functioning the same as this invention because Culpepper requires that the packet of money remain in a fixed location. In Culpepper, its alarm mechanism is triggered when the packet of cash is removed from the drawer. This prevents the cash from

being moved for the convenience of the owners and may result in an inadvertent and unintended triggering of alarms.

Applicants' invention, as now amended, differs from Culpepper in that it uses triggers located near the doors of the facility to activate its beacon. This provides the ability to move the cash packets within the facility. More important, eliminates the possibility of false alarms that made her due to the triggering mechanism used by Culpepper.

To more specifically define Applicants' invention over that disclosed by Culpepper, additional structural limitations have been added to the independent claims 1, 9 and 14. In particular, the trigger mechanism located near the door which activates the beacon as the package is moved through the door. This is supported in the specification as originally filed on page 5, lines 15-16.

Further, Culpepper is limited to cash packets. Applicants' invention is directed to any type of article which may need safeguarding. Claim 14, in particular, is directed to the protection of any type of valuable article, and not just to cash packets.

2. **Culpepper does not disclose the purpose, means or mechanism that this invention discloses.**

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. v. Aluminum Company of America, 120 U.S.P.Q. 362.

Culpepper cannot meet these objects of Applicants' invention can, because it does not disclose or discuss triggering mechanisms arranged at the perimeter of a facility which allow free movement of articles within the facility.

**3. Culpepper does not solve the problems that this invention solves.**

There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

Culpepper would cause an automatic false alarm if its packets were moved within the facility. Applicants' convention, and is now claimed, eliminates this problem. The only way that alone would be triggered using applicants' invention would be to physically remove the article from the facility. Culpepper would trigger an alarm purely by accidental movement of the money packet within a drawer.

**4. Culpepper does not disclose each and every element of this invention.**

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Culpepper does not disclose a means to activate the alarm system when the protected article is moved past the door of a facility. Applicants' independent claims, as now amended, expressly despite this structural element of the invention which does not appear in Culpepper.

For all the reasons set forth above, Applicants' invention is not anticipated by Culpepper.

**THE 103 REJECTION**

In item 8 of the office action, claims 3, 5-6, 11, 14-16 and 18-19 were rejected under 35 U.S.C. 103, as being unpatentable over Culpepper in view of Norris. In item 9 of the office action, claims 4, 7-8, 10 and 20 were rejected under 35 U.S.C. 103 as being unpatentable over

Culpepper in view of Anders. In item 10 of the office action, claim 20 was rejected under 35 U.S.C. 103 as being unpatentable over Culpepper in combination with Norris, and further in view of Anders. In item 11 of the office section, claims 12-13 and 17 were rejected under 35 U.S.C. 103 as being unpatentable over Culpepper in combination with Norris, and further in view of Otto. For ease of discussion, Culpepper, Norris, and Anders and Otto will be collectively referred to as the "Cited Art" Applicants' are responding to this basis of rejection as follows:

The Section 103 objection only applies:

. . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Applicants' invention is not obvious and thereby unpatentable in view of the Cited Art for the following reasons:

**The Cited Art does not make obvious Applicants' invention as a whole.**

The obviousness inquiry is not whether each element can be found in the prior art, but whether the prior art made obvious the invention as a whole. Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 5 U.S.P.Q.2d 1788 (Fed. Cir. 1988); Hartness Int'l. Inc. v. Simplimatic Eng. Co., 819 F.2d 1100, 1108, 2 U.S.P.Q. 1826, 1832 (Fed.Cir. 1987); and ACA Hosp.Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The Cited Art does not specifically teach an antitheft system which is triggered by movement of an article past door at the perimeter of a facility. Applicants' invention avoids inadvertent false alarms which may occur in the Cited Art. Cited Art does not provide the ability

to move articles freely within a facility, but which also automatically activates an alarm when they are moved through the door of the facility. Further, none of the Cited Art teaches or suggests a solution to the problem which Applicants' invention solves.

Structural limitations to the claims, as discussed above in regard to the rejection under 35 U.S.C. 102, have been added to the independent claims. If the Independent claims, as amended, are allowable, then the dependent claims should also be allowable. Applicants' Attorney believes that the claims, as now amended, are not obvious in light of the Cited Art, and respectfully requests the Examiner to reconsider the claims with a view towards allowance.

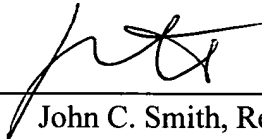
### **WORDING CORRECTIONS**

In addition to the amendments to the claims in response to the office action, applicant's attorney has also made minor wording/typographical corrections to the claims which will be self-evident in the claims.

### **CONCLUSION**

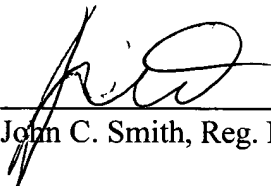
Applicants' Attorney thanks the Examiner for the Examiner's help in prosecuting this invention. In response to the office action, Applicants' Attorney has amended claims 1-9, 11-14 and 20; and canceled claim 10. Applicants' Attorney has been careful to avoid the introduction of new matter. In addition, a separate petition and fee for a three month extension of time is attached. Applicants' Attorney believes that all items in the office action dated December 4, 2003 have been addressed, and respectfully requests the Examiner to reconsider the claims, as amended, with a view towards allowance. Applicants' Attorney further invites the Examiner to contact Applicants' Attorney for a telephonic interview at the below listed number if the Examiner believes that prosecution of the application can be furthered by so doing.

Respectfully submitted,

By:   
John C. Smith, Reg. No. 33,284

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on: June 4, 2004  
Deposit Date

  
John C. Smith, Reg. No. 33,284

June 4, 2004  
Signature Date